

## **REMARKS**

This paper is filed in response to the Office Action dated February 11, 2004 and the Advisory Action dated July 8, 2004.<sup>1</sup> As this paper is filed on August 11, 2004 with a three-month extension of time and a Request for Continued Examination, the paper is timely filed.

### **I. Status of Amendments**

Claims 29-54 were pending prior to this response. No amendments are made by this response. Thus, claims 29-54 remain pending.

### **II. Response to the February 11 Office Action**

In the February 11 Office Action, claims 29-54 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by WO 00/32286 to Bennett et al. Moreover, the Office Action appears to suggest an obviousness-type rejection in the section titled "Response to Arguments," although only an allusion to the "previous prior art of record" is made, and no specific reference or references are cited. Applicants respond as follows.

#### **A. The Section 102 Rejection Should Be Withdrawn**

Claim 29 recites a method of conducting a slots game. The method includes receiving a wager, displaying a plurality of symbols arranged in a plurality of reels, and displaying at least one interactive symbol. The method further includes receiving a player selection of a selected symbol from the plurality of symbols, transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol, and determining a payout associated with a configuration of symbols including the transformed symbol and at least one other symbol of the plurality of symbols.

Bennett et al. does not disclose each and every limitation of the claimed subject matter of claim 29. As noted relative to Jaffe and Baerlocher, Bennett et al. does not disclose

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<sup>1</sup> The undersigned made repeated attempts to telephonically interview the examiner in regard to this case. Unfortunately, the undersigned's calls were not returned.

receiving a player selection of a selected symbol from the plurality of reels and transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. In this regard, applicants note that the rejection states: “Bennett also teaches that the triggering mechanisms that can be used in any of the forgoing embodiments can be one of a periodic trigger, random trigger, external triggering event, specific operator activity, and specific player activity (11:8-35).” However, claim 29 does not recite transforming a symbol through perceived interaction between an interactive symbol and the symbol according to a periodic trigger, random trigger, external triggering event, specific operator activity, or specific player activity; as noted above, claim 29 recites a player selection of a selected symbol from the plurality of symbols and interaction between an interactive symbol and the selected symbol. While claims are to be construed broadly during examination, they may not be construed so broadly as to ignore limitations recited in the claim. Consequently, Bennett et al. does not disclose each and every limitation of the claimed subject matter, and therefore does not anticipate the claimed subject matter.

In attempted rebuttal to applicants’ argument, an Advisory Action was issued, dated July 8, 2004. In the July 8 Advisory Action, the applicants were directed to “Fig. 28(a) [presumably of Bennett] wherein a player is given a selection of a plurality of items on a reel, whereupon a player selection, the interactive symbol is perceived to modify the selected symbol (Fig. 28(b)).” Applicants respectfully disagree with this characterization of Bennett. According to claim 29, the selected symbol is (i) one of the plurality of symbols arranged in a plurality of reels, and (ii) transformed into a transformed symbol through perceived interaction with the interactive symbol. Moreover, the method of claim 29 includes determining a payout associated with a configuration of symbols including the transformed symbol and at least one other symbol of the plurality of symbols. The allegedly corresponding selected symbol of Bennett (which applicant understands to be the “bundle”) does not meet each and every one of these limitations: (i) the allegedly corresponding selected symbol is not one of the plurality of symbols arranged in a reel, (ii) the allegedly corresponding selected symbol is not transformed into a transformed symbol through perceived interaction with the interactive symbol, and (iii) the allegedly corresponding transformed symbol is not included in a configuration of symbols with at least one other symbol of the plurality of symbols (arranged in reels) to determine a payout. Simply put, the

allegedly corresponding selected symbol of Bennett is not the selected symbol/transformed symbol of claim 29.

Claims 30-40 depend, either directly or indirectly, from claim 29. Because claim 29 is not anticipated by Bennett et al., claims 30-40 are also allowable.

Claim 41 recites a method of conducting a slots game. The method includes receiving a wager, receiving a player selection of at least one payline, displaying a plurality of symbols arranged in a plurality of reels, and displaying at least one interactive symbol. The method further includes receiving a player selection of a selected symbol from the plurality of symbols, transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol, and determining a payout associated with a set of symbols including the transformed symbol and at least one other symbol of the plurality of symbols arranged along the at least one payline.

Claim 41, like claim 29, recites receiving a player selection of a selected symbol from the plurality of symbols and transforming the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. Applicants also note that claim 41 recites "determining a payout associated with a set of symbols including the transformed symbol and at least one other symbol of the plurality of symbols arranged along the at least one payline." Consequently, applicants submit that the arguments made above relative to claim 29 apply with equal force to claim 41. Moreover, as claim 41 is allowable, claim 42 that depends from claim 41 also is allowable.

Claim 43 recites a gaming device. The gaming device includes a display device, a wager acceptor device, a user input device, and a microprocessor coupled to the display device, the wager acceptor device, and the user input device, the microprocessor including a central processing unit and memory. The microprocessor is programmed to receive a wager via the wager acceptor device, to display a plurality of symbols arranged in a plurality of reels on the display device, and to display at least one interactive symbol on the display device. The microprocessor is programmed to receive a player selection of a selected symbol from the plurality of symbols via the user input device, to transform the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol, and to determine a payout associated with a configuration of

symbols including the transformed symbol and at least one other symbol of the plurality of symbols.

Claim 43, similar to claim 29, recites a microprocessor is programmed to receive a player selection of a selected symbol from the plurality of symbols and to transform the selected symbol into a transformed symbol through perceived interaction between the at least one interactive symbol and the selected symbol. Moreover, applicants note that claim 43 recites that the microprocessor is programmed “to determine a payout associated with a configuration of symbols including the transformed symbol and at least one other symbol of the plurality of symbols.” Consequently, applicants submit that the arguments made above relative to claim 29 apply with equal force to claim 43. Moreover, as claim 43 is allowable, claims 44-54 that depend directly or indirectly from claim 43 also are allowable.

**B. Other Rejections**

In regard to the obviousness-type rejection, applicants initially submit that no references have been specifically identified, and clearly explained, as is required by 37 C.F.R. 1.104(c)(2). According to 1.104(c)(2): “[T]he examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Applicants submit that this has not been done in this instance, either in the February 11 Office Action or the July 8 Advisory Action.

Given that there is no identification of the reference or references relied on for the obviousness-type rejection, applicants’ remarks regarding the obviousness-type rejection are accordingly limited. However, applicants will respond to the teachings and suggestions alleged to provide the limitations identified as missing in the “prior art.”

At the outset, applicants’ claimed limitation of receiving a player selection of a selected symbol from the plurality of symbols is characterized as nothing more than a “randomization mechanism.” Applicants disagree. It is believed that permitting the player to select the symbol to be interacted with the interactive symbol adds significantly to the player’s perception of the operation of the method or the device, and thus is of significant psychological value. It is believed that by permitting the player to select the symbol to be transformed by perceived interaction with the interactive symbol, the player has the

impression that he or she is in control of the method or machine to a much greater degree than if the computer performs a random selection of the symbols to interact and transform. It is further believed that this sense of control increases the player's trust in the fairness of the machine, even if the transformation of the selected symbol occurs according to a randomly or pseudo-randomly selected outcome. Consequently, applicants submit that this limitation is more than just another randomization method.

Further, applicants' disclosure at paragraph 14 is relied on for its discussion of the interchangeability of random selection and player selection. Applicants believe that this reliance is inappropriate, because the language in paragraph 14 is not an admission regarding the prior art, but is a statement of that which is not in the prior art. In particular, paragraph 14 recites: "[t]hus, *in view of the shortcomings of the art*, it would be advantageous to provide a gaming device and method which incorporates at least one interactive symbol for interacting with at least one other symbol to produce a third symbol through randomness and/or player interaction." It should be evident that this sentence, while in the section of the specification titled "Background of the Invention," describes not that which is in the prior art, but that which is missing in the prior art and which may be present in applicants' claimed invention. In this regard, one is reminded of the cautions against using the applicants' claimed invention as a roadmap or blueprint for combining the references relied upon.

As for the suggestion that the missing limitations may be taught by reference to the allegedly anticipatory reference of Bennett et al., applicants have addressed above why Bennett et al. does not show each and every limitation of the claimed invention. Therefore, this alleged teaching or suggestion also fails.

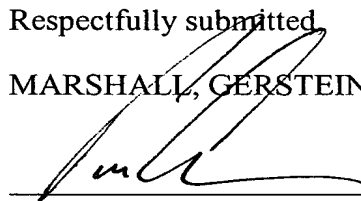
In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is requested to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

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By:



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Paul C. Craane  
Registration No. 38,851  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300